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| APPLICATION NO.            | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------|------------------|
| 09/772,918                 | 01/31/2001  | Hideyuki Amaku       | 826.1671/JDH        | 9990             |
| 21171                      | 7590        | 11/16/2007           | EXAMINER            |                  |
| STAAS & HALSEY LLP         |             |                      | NGUYEN, MERILYN P   |                  |
| SUITE 700                  |             |                      | ART UNIT            | PAPER NUMBER     |
| 1201 NEW YORK AVENUE, N.W. |             |                      | 2163                |                  |
| WASHINGTON, DC 20005       |             |                      | MAIL DATE           | DELIVERY MODE    |
|                            |             |                      | 11/16/2007          | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                               |                  |
|------------------------------|-------------------------------|------------------|
| <b>Office Action Summary</b> | Application No.               | Applicant(s)     |
|                              | 09/772,918                    | AMAKU ET AL.     |
|                              | Examiner<br>Marilyn P. Nguyen | Art Unit<br>2163 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 August 2007.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3,8,9,12 and 13 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 1-3,8,9 and 13 is/are allowed.  
 6) Claim(s) 12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 31 January 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: Detailed action.

## DETAILED ACTION

1. This application claims foreign priority Application No. 2000-181687 filed on June 16, 2000.
2. In response to the communication dated 08/20/2007, claims 1, 2, 3, 8, 9, 12 and 13 are active in this application.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 12 stands rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

#### *As set forth in MPEP 21 06(II)A:*

Identify and understand Any Practical Application Asserted for the Invention The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96).<sup>1</sup> In re Ziegler, 992, F.2d 1 197, 1200-03, 26 USPQZd 1600, 1603-06 (Fed. Cir. 1993). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a "useful, concrete and tangible result". The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a §101 judicial exception, in that the process claim must set forth a practical application of that §101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application").

In the present case, claimed invention (Claim 12) recites a propagating signal. Propagating signal is a carrier in a form of energy which is not a process, machine, manufacture, nor composition of matter, thus is a non statutory subject matter.

***Response to Remarks/Arguments***

4. Applicant's remarks/arguments filed on 08/20/2007 about the claim rejection of the last Office Action have been fully considered, but they are not persuasive in response to the remark on the 101 rejection..

**Response to Applicant's Remark on the 101 Rejection:**

Applicant argues that claim 12 is statutory per se as signals are an article of manufacture. The Examiner respectfully disagrees. As addressed above, Propagating signal is a carrier in a form of energy which is not a process, machine, manufacture, nor composition of matter, thus is a non statutory subject matter.

***Allowable subject matter***

5. Claims 1, 2, 3, 8, 9 and 13 are allowed. The following is a statement of reasons for the indication of allowable subject matter:

None of the references of record (Enko, US 6,078,944) teaches or suggests the claimed (Claims 1, 8, 9 and 13) invention having or comprising, in addition to the other limitations of the claims, the limitation of the process information of the specific system recorded in a shared storage medium (Shared memory 140, Fig. 1) that is shared by a plurality of systems including

the specific system and is commonly searched by the plurality of systems and that collectively stores a plurality of pieces of process information of the plurality of systems, in a format such that a process information of the entire system comprising the plurality of systems is collectively managed by the shared storage medium and a process history of the plurality of systems can be tracked without requiring access to the specific system, **each system of a plurality of systems comprising a processor, a memory, an external storage, and a separate operating system** (Emphasis added).

None of the references of record (Enko, US 6,078,944) teaches or suggests the claimed (Claims 2 and 3) invention having or comprising, in addition to the other limitations of the claims, the limitation of wherein when the shared storage medium stores output identification information related to an output content of a preceding process before a current process in the specific system, said generation device generates service identification information of the current process, obtains the output identification information of the preceding process from the shared storage medium, generates input identification information related to an input content of the current process, generates output identification information related to an output content of the current process by concatenating the input identification information and the service identification information into the output identification information and generates the process information of the specific system by relating the service identification information, the input identification information, the output identification information and a content of the current process to each other.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 571-272-4026.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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Art Unit: 2163

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November 09, 2007



WILSON LEE  
PRIMARY EXAMINER